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Attorney Docket No. 49233 (71117)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

JUN 30 2003

APPLICANT: Masato Takeuchi et al.

U.S.S.N. 09/369,690 Art Unit: 2155 Technology Center 2100

FILED: August 6, 1999 Examiner: Won, Young N.

FOR: INFORMATION PROCESSING DEVICE AND STORAGE MEDIUM WITH A
REPLY-PREPARING PROGRAM READABLE BY A COMPUTER

CERTIFICATE OF EXPRESS MAILING (Label No.: EV 342613740 US)

I certify that this document fee is being deposited on April 23, 2003 with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37CFR in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 23, 2003.

By: Nicole M. McKinnon
Nicole M. McKinnon

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

RESPONSE UNDER 37 C.F.R. § 1.115

Sir:

Claims 1-7 are pending in the present application.

I. FORMAL MATTERS

Applicant notes with appreciation that the Office Action again acknowledges the claim to priority and indicates that the certified copy of the priority document has been received.

The present office action, and the previous office actions dated March 27, 2002 and August 28, 2002, do not include a copy of the PTO Form 1449 that was submitted in the Information Disclosure Statement filed on November 23, 1999, as requested in the Amendment filed on November 27, 2002. Applicant respectfully requests the Examiner to send to the undersigned a copy of this PTO Form 1449 with the reference initialed by the Examiner, thereby indicating that this reference was considered.

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)

Applicant(s): Masato Takeuchi, et al.

Docket No.

49233 (71117)

Serial No.

09/369,690

Filing Date

August 6, 1999

Examiner

Won, Young N.

Group Art Unit

2155

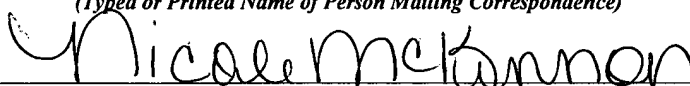
Invention:

INFORMATION PROCESSING DEVICE AND STORAGE MEDIUM WITH A REPLY-PREPARING PROGRAM READABLE BY A COMPUTER

I hereby certify that the following correspondence:

Response Under 37 C.F.R. Section 1.115 (along with related documents)*(Identify type of correspondence)*

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on

June 23, 2003*(Date)*Nicole M. McKinnon*(Typed or Printed Name of Person Mailing Correspondence)**(Signature of Person Mailing Correspondence)*EV 342613740 US*("Express Mail" Mailing Label Number)***RECEIVED**

JUN 30 2003

Technology Center 2100

Note: Each paper must have its own certificate of mailing.

The Office Action does not indicate whether the proposed drawing corrections filed on June 24, 2002 are acceptable, as requested in the Amendment filed on November 27, 2002. Applicant respectfully requests the Examiner to do so.

II. PRIOR ART REJECTION

Claims 1-7, are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,085,201 (Tso). This rejection is traversed.

In the amendment filed on February 28, 2003, Applicant argued that Tso does not teach or suggest a system that performs the function of: (1) enabling a user to select from a received mail a portion to be used directly in a reply mail; and (2) preparing a reply mail by coupling the selected contents of the received mail with the selected answer examples.

In response to these arguments, the Examiner asserts that Tso clearly teaches the function of enabling a user to select from a received mail a portion to be used directly in a reply mail, and preparing a reply mail by coupling the selected contents of the received mail with the selected answer examples.

Applicant submits that Tso does not teach or suggest to prepare a reply mail by coupling at least one or more portions of the contents of a received mail with answer examples, as recited by the independent claims 1, 4, 5, 6 and 7. In the system taught by Tso, the reply e-mail is not formed from the contents of the received mail. Rather, the entire contents of the reply e-mail is formed from a template (see column 5, line 66 – column 6, line 33). Applicant submits that Tso does not teach or suggest to do this. Further Applicant submits that this feature is certainly not inherent in Tso, and Tso does not necessarily have to perform this step. Applicant submits that an allegedly inherent feature of a reference must be consistent, necessary, and inevitable, not merely possible or probable.

The Examiner relies on column 4, lines 31-36 of Tso to assert that Tso teaches to require a user to pick from the received e-mail at least one or more contents for a reply mail. Applicant submits that in the system taught by Tso, the contents of the received e-mail are used only to choose a template (see column 4, line 31– column 6, line 25). The contents of the received e-mail are not inserted into the reply e-mail, as recited in independent claims 1, 4, 5, 6, and 7. Specifically, in column 4, line 33 through column 5, line 53, Tso teaches:

"the user selects a text string to be processed [t]he template engine 5 then uses the extracted words to search the set of predefined templates stored in the template database 4 (Step 232) ... Once the template engine determines the most appropriate template, it passes the template to the user interface 2 for

presentation to the user (step 233) ... The user could then select which template is most appropriate for that user's purposes."

This template that is selected by the user is then inserted into the reply mail.

The Examiner relies on column 6, lines 66-67 and column 7, lines for the assertion that Tso teaches to couple contents of a received e-mail and with answer examples. Applicants submits that these sections of Tso teach to insert text generated by the template into the reply e-mail. These sections of Tso, and no other sections of Tso, teach to prepare a reply mail by inserting actual portions of the received mail into the reply mail.


Since Tso does not teach or suggest this feature of the independent claims, Applicants submits that the rejection of claims 1-7 under 35 U.S.C. § 102(e) is improper and respectfully requests that it be withdrawn.

Based on the foregoing, Applicant submits that the present application is in condition for allowance. Applicant kindly requests the Examiner to contact the undersigned at the phone number listed below to discuss this application, if the Examiner feels that such discussion may expedite prosecution of the present application.

Applicant believes that no additional fees are due for the subject application. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully Submitted,

Date: June 23, 2003
Customer No.: 21874



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